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| EXAMINER |
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GRAHAM, CLEMENT B

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| ART UNIT | PAPER NUMBER |
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3692

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01/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/062,156 | Applicant(s) MINEAR ET AL. | |
| | Examiner Clement B. Graham | Art Unit 3692 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Claim Rejections - 35 USC § 112

1 The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 7, 11, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, Claims 1, 7, 11, and 19, recites the ["receiving metadata associated with an application and presenting the metadata associated with the application to the receiver entity;"].

However this language fails to distinctly claim Applicant's invention because the scope of the claim is unclear the specification fails to clarify, the meaning of the limitation, further meta data represents data that describes other data or objects , what is the description of the meta data and, what is the usage of this meta data in these claims? is it just for transmitting and receiving?.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Hori et al (Hereinafter Hori U.S Patent 6, 792, 280).

As per claim 1, Hori discloses a method for performing automated distribution and billing, comprising: providing a negotiation forum between a delivery entity and a receiver entity; receiving metadata associated with an application from a delivery entity.(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column

3 lines 20-38 and column 4 lines 10-24) presenting the metadata associated with the application to the receiver entity; receiving an acceptance of the metadata by the delivery entity and the receiver entity; configuring a catalog for the receiving entity associating the application and the metadata in a central repository; receiving indication that a transaction of the product occurred and sending the catalog (i. e, coupon) information to the receiver entity.(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) transmitting billing information to the receiver entity.(see column 6 lines 19-28 and column 8 lines 58-67).

As per claim 2, Hori discloses wherein the transaction includes information about the application being downloaded to a wireless device. .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 3, Hori discloses wherein the negotiation forum uses a secure extranet accessible by the delivery and receiver entity. .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 4, Hori discloses wherein the metadata includes billing information associated with the application. .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 5, Hori discloses wherein the receiver entity is a carrier. .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 6, Hori discloses wherein in the delivery entity is a developer. .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 7, Hori discloses a system for performing automated distribution and billing, comprising:

means for providing a negotiation forum between a delivery entity and a receiver entity;
means for receiving metadata associated with an application from a delivery entity;
means for presenting the metadata associated with the application to the receiver entity;
means for receiving an acceptance of the metadata by the delivery entity and the receiver entity.(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67)

means for configuring a catalog for the receiving entity associating the application and the metadata in a central repository means for sending the catalog ("i. e, coupon") information to the receiver entity.(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67)

means for receiving indication that a transaction of the product occurred.(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) and means for transmitting billing information to the receiver entity. .(see column 6 lines 19-28 and column 8 lines 58-67).

As per claim 8, Hori discloses wherein the transaction includes information about the application being downloaded to a wireless device. (note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 9, Hori discloses wherein the negotiation forum uses a secure extranet accessible by the delivery and receiver entity.(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 10, Hori discloses wherein the metadata includes billing information associated with the application. (note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 11, Hori discloses a computer-readable medium having computer executable instructions that when execute perform a method for performing automated distribution and billing, comprising: providing a negotiation forum between a delivery

entity and a receiver entity .(note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) receiving metadata associated with an application from a delivery entity; presenting the metadata associated with the application to the receiver entity; receiving an acceptance of the metadata by the delivery entity and the receiver entity; configuring a catalog for the receiving entity associating the application and the metadata in a central repository.(note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) sending the catalog ("i.e, coupon") information to the receiver entity receiving indication that a transaction of the product occurred.(note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) and transmitting billing information to the receiver entity. (see column 6 lines 19-28 and column 8 lines 58-67).

As per claim 12, Hori discloses wherein the transaction includes information about the application being downloaded to a wireless device. (note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 13, Hori discloses wherein the negotiation forum uses a secure extranet accessible by the delivery and receiver entity.(note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 14, Hori discloses wherein the metadata includes billing information associated with the application. (note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 15, Hori discloses an automated distribution and billing system, comprising:
an extranet accessible by multiple carriers and multiple developers and which use as a negotiation forum;
a server having a central repository that stores metadata associated with an application;

and a transaction server to receive transaction data associated with the downloading of a product and, using the metadata.(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) determines billing information associated with the downloading of the product.(see column 6 lines 19-28 and column 8 lines 58-67).

As per claim 16, Hori discloses wherein the transaction server sends the billing information to a carrier. .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) .

As per claim 17, Hori discloses wherein the transaction server sends the billing information to a developer. (note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) .

As per claim 18, Hori discloses wherein the transaction data is associated with a product is downloaded to a wireless device. .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67).

As per claim 19, Hori discloses a system for distributing applications over a wireless network, comprising:
a centralized processor operable to perform administrative functions associated with downloading an application to a wireless device .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) a local processor connected to the centralized processor and operable to receive catalog data and the application from the centralized processor, to transmit the catalog and application to the wireless device, and to record transaction data associated with the transmission of the application .(note abstract and see column 1 lines 40-67 and column 2 lines1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) and a transaction server connected to the centralized processor and the local processor and operable to receive metadata information from the centralized processor, receive transaction data from the local processor, and

process the metadata.(note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) information and transaction data for billing.(see column 6 lines 19-28 and column 8 lines 58-67).

Conclusion

RESPONSE TO ARGUMENTS

5. Applicant's arguments filed 8/26/2007 has been fully considered but they are moot in view of new grounds of rejections.

6. In response to Applicant's argument that as it pertains to Hori and further state that prior art fail to teach or suggest" providing negotiation forum between and the delivery entity and the receiver entity or receiving at the negotiation forum, metadata associated with an application from a delivery entity and receiving music, and send portable communication delivery server and configuring a catalog and receiving entity associating the application and the metadata in the central repository" the examiner disagrees with Applicant's because these limitations were addressed as stated.

Hori discloses a method for performing automated distribution and billing, comprising: providing a negotiation forum between a delivery entity and a receiver entity; receiving metadata associated with an application from a delivery entity.(note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24) presenting the metadata associated with the application to the receiver entity; receiving an acceptance of the metadata by the delivery entity and the receiver entity; configuring a catalog for the receiving entity associating the application and the metadata in a central repository; receiving indication that a transaction of the product occurred and sending the catalog (i. e, coupon) information to the receiver entity.(note abstract and see column 1 lines 40-67 and column 2 lines 1-67 and column 3 lines 20-38 and column 4 lines 10-24 and column 17-18 lines 1-67) transmitting billing information to the receiver entity.(see column 6 lines 19-28 and column 8 lines 58-67).

Therefore it is inherently clear that Applicant's claim limitation were addressed with the teachings of Hori.

7. Applicant's claims 1, 7, 11, 19, states **"configuring a catalog for receiving" instructions which when executed" operable to perform and receive"**

However the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

****>**USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous.

Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").<

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571272-6777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number:
10/062,156
Art Unit: 3692

Page 10

CG

March 22, 2007


FRANTZY POINVIL
PRIMARY EXAMINER
